REMARKS

In the Office Action[1], the Examiner took the following actions:

rejected claim 2 under 35 U.S.C. § 112, first paragraph;

rejected claims 2 and 3 under 35 U.S.C. § 112, second paragraph;

rejected claims 1-10, 12, 13, and 16 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,643,825 to Li et al. ("*Li*");

rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of U.S. Patent 6,470,381 to De Boor et al. ("*De Boor*");

rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of U.S. Patent 6,247,066 to Tanaka et al. ("*Tanaka*");

rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of U.S. Patent 5,754,840 to Rivette et al. ("*Rivette*").

Applicants have amended claims 1, 2, 4-11, 13, and 14. Claim 3 has been canceled without prejudice or disclaimer. New claim 17 has been added. Accordingly, claims 1, 2, and 4-17 are currently pending.

I. Regarding the rejection of claim 2 under 35 U.S.C. § 112, first paragraph

Regarding the rejection of claim 2 under 35 U.S.C. § 112, first paragraph, the Examiner rejected the claim as "contain[ing] subject matter which was not described in the specification." (Office Action at p. 2). Specifically, the Examiner alleges that the

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[1] The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

"writing format" of claim 2 "is not described in the specification." (Office Action at p. 2). Applicants respectfully disagree.

However, in an effort to advance prosecution, Applicants have amended claim 2 to recite that the screen is displayed "using a web browser," which is fully supported by the specification at, for example, page 30, lines 7-9, thereby obviating the 112, first paragraph rejection. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claim 2 under 35 U.S.C. § 112, first paragraph.

II. Regarding the rejection of claims 2 and 3 under 35 U.S.C. § 112, second paragraph

Regarding the rejection of claim 2 and 3 under 35 U.S.C. § 112, second paragraph, the Examiner rejected the claim because "the phrase 'such as' renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention." (Office Action at p. 3). Applicants respectfully traverse the rejection. However, to expedite prosecution, Applicants and have amended claim 2 and canceled claim 3, thereby obviating the 112, second paragraph rejections. Accordingly, Applicants respectfully request the reconsideration and withdrawal of the rejection of claims 2 and 3 under 35 U.S.C. § 112, second paragraph.

I. Regarding the rejection of claims 1-10, 12, 13, and 16 under 35 U.S.C. §102(e) as being anticipated by *Li*

Applicants respectfully traverse the rejection of claims 1-10, 12, 13, and 16 under 35 U.S.C. § 102(e) as anticipated by *Li*. In order to properly establish that *Li* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of

the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

For example, amended claim 1 recites, among other things, a program causing a computer terminal to:

> <u>determine</u> whether a display format of the user terminal is <u>dependent on an operating system</u> of the user terminal;
>
> <u>display a screen</u> in window format, <u>using functionality of the operating system</u>, on a display section of the user terminal if it is determined that the display format is dependent on an operating system;
>
> <u>display a screen</u> in web format, <u>using a web browser</u>, on the display section of the user terminal if it is determined that the display format is not dependent on an operating system.

(emphasis added). *Li* does not disclose at least these elements of claim 1.

Li discloses a system whereby "[s]creens generated by a host application are reformatted for viewing by applying styles to the host screens in response to recognized components included therein." (*Li*, Abstract). Specifically, "a host screen is provided to a user, such as a developer ... [t]he user selects a desired style to be applied to the host screen ... a first data structure ... is generated and stored that includes a description of the components of selected style to be recognized at run-time for reformatting the host screen." (*Li*, col. 4, lines 55-63). Furthermore, "developers ... can develop the styles and layouts of the reformatted screens while end user, who may be

less familiar with programming aspects, can use the application without needing to understand how to reformat the host screens." (*Li*, col. 5, lines 9-13).

These styles define "a desired look and layout to be applied to a respective host screen . . . [t]he first style is applied to the host screen in which the first component is recognized and the second style is applied to the host screen in which the second component is recognized." (*Li*, col. 4, lines 29-39) (emphasis added). This does not constitute "determin[ing] whether a display format of the user terminal is dependent on an operating system of the user terminal; display[ing] a screen . . . using functionality of the operating system . . . if it is determined that the display format is dependent on an operating system; and display[ing] a screen . . . using a web browser . . . if it is determined that the display format is not dependent on an operating system" as recited in amended claim 1.

The Examiner cites to column 6, lines 2-6 and column 5, lines 30-32 of *Li* as disclosing the ability to display a screen in web format. (Office Action at pp. 3-4). While the cited portions of *Li* discuss that a "web style" can be applied to a host screen, *Li* further discloses that "a user may be presented with several layout options for the reformatted screen such as a Web style and a traditional style. The user selects the desired layout options via the GUI." (*Li*, col. 6, lines 64-67). Thus, *Li* does not disclose the ability to "determine whether a display format of the user terminal is dependent on an operating system of the user terminal; display a screen . . . using functionality of the operating system . . . if it is determined that the display format is dependent on an operating system; and display a screen . . . using a web browser . . . if it is determined that the display format is not dependent on an operating system" as recited in amended

claim 1. Accordingly, *Li* cannot anticipate claim 1. Thus, claim 1 is allowable for at least these reasons.

Independent claims 2 and 7, while of different scope, recites elements similar to those of claim 1 and are thus allowable over *Li* for at least the same reasons discussed above in regard to claim 1. Claims 4 and 6 are allowable at least due to their dependence from claim 1 or 2. Claims 8-10, 12, 13, and 16 are also allowable at least due to the dependence from claim 7.

II. Regarding the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *De Boor*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 11. A *prima facie* case of obviousness has not been established with respect to these claims.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. §2143.01(III) (emphasis in original). "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences <u>themselves</u> would have been obvious, but whether the claimed invention <u>as a whole</u> would have been obvious." M.P.E.P. § 2141.02(I), (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claim 11 depends from claim 8, which depends on claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach each and every element of claim 7. Moreover, *De Boor* fails to cure the deficiencies of *Li* and would not render obvious the claimed invention.

The Examiner correctly states that *Li* "does not explicitly show when the screen is changed or a cursor position is changed on the screen . . . a corresponding relationship between the input assisting functions and the function keys . . . changes display of the names of the input assisting functions on the screen." (Office Action at p. 10). However, the Examiner contends that *De Boor* discloses in column 9, lines 14-22, "function keys that have variable functionality that changed depending on the particular screen display of the user interface being shown." (Office Action at p. 10).

Even assuming the Examiner's characterization of *De Boor* is correct, a point which Applicants do not concede, amended claim 11 requires "when a cursor position is changed on the screen, the key task processing system changes a corresponding relationship between the input assisting functions and the function keys and changes display of the names . . . on the screen." Column 9, lines 14-22 of *De Boor* disclose "programmable softkeys 130 which have variable functionality that changes dependent on the particular screen display of the user interface." (emphasis added). *De Boor* does not disclose any ability to change the displayed name based on a change in cursor position.

Furthermore, *De Boor* does not compensate for the deficiencies of *Li*, in that *De Boor* does not disclose or render obvious "determining whether a display format of a user terminal is dependent on an operating system of the user terminal; . . . displaying a screen . . . using functionality of the operating system, if it is determined that the display format is dependent on an operating system; . . . displaying a screen . . . using a web browser, if it is determined that the display format is not dependent on an operating system" as recited in amended claim 7 and required by claim 11.

In view of the mischaracterization of the *De Boor* reference, above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 11. Thus, the Examiner has failed to clearly articulate a reason why claim 11 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully

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request that the Examiner withdraw the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *De Boor*.

III. Regarding the rejection of claims 14 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Tanaka*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 14. A *prima facie* case of obviousness has not been established with respect to these claims.

Claim 14 depends from claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach each and every element of claim 7. Moreover, *Tanaka* fails to cure the deficiencies of *Li* and would not render obvious the claimed invention.

The Examiner correctly states that *Li* "does not explicitly show a function which is set by accepting the setting of a row name, a data type and a data length of the added row as arguments of the function . . . and which executes a writing/saving processing stor[ing] the data of the newly added row." (Office Action at p. 11). However, the Examiner contends that *Tanaka* discloses in column 12, lines 1-8, "a compound document processing system that adds a new row the command argument and inserts the name and meaning of the argument into the added row." (Office Action at p. 11). The Examiner further contends that *Tanaka* discloses in col. 6, lines 62-67, "the row in the table stores the types and corresponding functions." (Office Action at p. 11).

Even assuming the Examiner's characterization of *Tanaka* is correct, a point which Applicants do not concede, claim 14 requires a function "which is set by accepting the setting of a row name, <u>a data type and a data length of the added row as</u>

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<u>arguments</u> of the function." (emphasis added). The Examiner does not point to any portion of *Tanaka* that discloses the required data type and data length arguments, and *Tanaka* does not teach or render obvious a function accepting a data type and a data length, among other things. Furthermore, *Tanaka* does not compensate for the deficiencies of *Li* in that *Tanaka* does not teach or suggest "determining whether a display format of a user terminal is dependent on an operating system of the user terminal; . . . displaying a screen . . . using functionality of the operating system, if it is determined that the display format is dependent on an operating system; . . . displaying a screen . . . using a web browser, if it is determined that the display format is not dependent on an operating system" as recited in amended claim 7 and required by claim 14.

In view of the mischaracterization of the *Tanaka* reference, above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 14. Thus, the Examiner has failed to clearly articulate a reason why claim 14 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Tanaka*.

IV. Regarding the rejection of claims 15 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Rivette*

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 15. A *prima facie* case of obviousness has not been established with respect to these claims.

Claim 15 depends from claim 7 and thus requires each and every element of claim 7. As set forth above, *Li* fails to teach each and every element of claim 7. Moreover, *Rivette* fails to cure the deficiencies of *Li* and would not render obvious the claimed invention.

The Examiner correctly states that *Li* "fails to explicitly show an additional menu definition file which defines contents of additional menu items to be displayed on a menu bar" and the associated display/calling execution file means. (See Office Action at p. 12). However, the Examiner contends that *Rivette* discloses in column 10, lines 62-67, and column 11, lines 1-5, "an edit drop down menu on a menu bar . . . adding a command button or menu command to a menu command button . . . in the word processing window . . . and the action is performed (i.e. executes a related execution file, with the addition menu is related when the additional menu is selected." (Office Action at p. 12). This is not correct.

The Examiner has misinterpreted the cited portion of *Rivette*. The cited portion of *Rivette* states that "[a]fter the user has completed editing the selected text, the user selects a 'Done Editing' command from the Edit drop down menu ... [o]ther methods <u>for signaling the editing</u> of the selected text <u>could also be used</u>, such as adding a command button or menu command in the word processing window." (emphasis added). *Rivette* is simply noting that there could be differing embodiments of the invention, where a

user, instead of selecting the "Done Editing" command, could instead add a specific command button or menu command to signify that the user has completed editing of the selected text. This does not constitute "an additional menu definition file which defines contents of additional menu items to be displayed on a menu bar . . . and an additional menu display/calling execution file which reads a menu title or a menu button . . . and an additional menu group . . . [and] displays them on the menu bar" a required by claim 15.

Additionally, the Examiner has failed to point out any portion of *Rivette* which discloses the required element of "an additional menu definition file which defines contents of additional menu items to be displayed on a menu bar" as required by claim 15. Finally, *Rivette* does not compensate for the deficiencies of *Li* in that *Rivette* does not teach or suggest "determining whether a display format of a user terminal is dependent on an operating system of the user terminal; . . . displaying a screen . . . using functionality of the operating system, if it is determined that the display format is dependent on an operating system; . . . displaying a screen . . . using a web browser, if it is determined that the display format is not dependent on an operating system" as recited in amended claim 7 and required by claim 15.

Applicants note that the motivation to combine the references given by the Examiner, "to efficiently manipulate a word processing document," (Office Action at p. 13), is not a proper motivational statement for supporting a rejection under 35 U.S.C. § 103. As noted above, M.P.E.P § 2142 notes that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must

be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (emphasis added).

Rivette is directed to a "method for assisting in the preparation of a document, and for analyzing a document, such as a patent or patent application . . . [t]he system aids a user to verify that terms in a patent application are being used consistently." (*Rivette*, Abstract). As noted above, *Li*, on the other hand, is directed to reformatting "[s]creens generated by a host application." (*Li*, Abstract). Accordingly, *Rivette* is not concerned in any way with any issues addressed by *Li*, and in fact, the Examiner notes that the only commonality between the two is that *Li* "includes a menu." (Office Action at p. 12). Thousands of granted patents contain the common element of a menu, however, this is not an automatic motivation to combine all of their teachings. The Examiner's motivational statement in this instance is a mere conclusory statement, not supported by any articulated reasoning with some rational underpinning as to why it would be at all obvious to combine specific portions of *Rivette* with the teachings of *Li*.

In view of the mischaracterization of the *Rivette* reference, above, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 15. Thus, the Examiner has failed to clearly articulate a reason why claim 15 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established. Applicants therefore respectfully request that the Examiner withdraw the rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Rivette*.

V. New Claim 17

New claim 17 depends from allowable independent claim 7 and allowable dependent claims 8 and 11. Accordingly, Applicants respectfully request that the Examiner allow new claim 17.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.
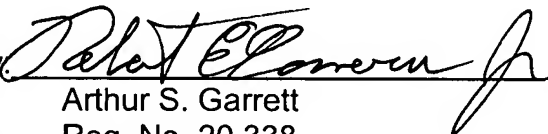
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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